

### **REMARKS**

In the Office Action, the Examiner rejected claim 19 under 35 U.S.C. § 112, first paragraph; rejected claims 1, 9, 17, 19, 20, and 28-34 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,758,259 to Lawler ("*Lawler*") in view of U.S. Patent No. 6,029,176 to Cannon ("*Cannon*"); and rejected claim 27 under 35 U.S.C. § 103(a) as unpatentable over *Lawler* and *Cannon* in view of U.S. Patent No. 5,977,964 to Williams et al. ("*Williams*").

By this amendment, Applicants amend claims 1, 9, 17, 19, 30-32, and 34, and cancel claims 2-8, 10-16, 18, 21-26, 28, and 29 without prejudice or disclaimer.

#### **I. The Rejection of Claim 19 under 35 U.S.C. § 112, first paragraph**

The Office Action alleges that claim 19 lacks support in the specification (Office Action at pages 2-3). Applicants respectfully traverse, and maintain that claim 19 is fully supported for at least the reasons set forth in the Amendment After Final filed January 27, 2009. Nevertheless, solely for the purpose of expediting prosecution, Applicants have amended claim 19 herein based on the Examiner's suggestions on pages 2-3 in the Office Action. Accordingly, Applicants respectfully request the Examiner to withdraw the rejection.

#### **II. The Rejection of Claims 1, 9, 17, 19, 20, and 28-34 under 35 U.S.C. § 103(a)**

Applicants respectfully traverse the rejection of claims 1, 9, 17, 19, 20, and 28-34 under 35 U.S.C. § 103(a).

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. See M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007). Such an analysis should be made

explicit and cannot be premised upon mere conclusory statements. See id. "A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention." M.P.E.P. § 2145.

Furthermore, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art" at the time the invention was made.

M.P.E.P. § 2143.01(III), internal citation omitted. Moreover, "[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." M.P.E.P. § 2141.02(I), internal citations omitted (emphasis in original).

"[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1996) . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art." M.P.E.P. § 2141(II). "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. § 2141(III). In this application, a *prima facie* case of obviousness has not been established because the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the claimed invention and the prior art. Accordingly, the Office Action has failed to clearly articulate a reason why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art.

Independent claim 1, for example, recites a server operational expenses collecting method, comprising, among other things, "storing data in a program viewing log reflecting a first duration of time that a first viewer viewed a first program, the first program corresponding to a first program category from a plurality of program categories[, and] comparing the duration of time the first viewer viewed the first program to a threshold duration particular to the first program category" (emphasis added).

*Lawler* discloses a method of identifying a preferred program for a viewer of interactive television (*Lawler*, abstract). *Lawler* discloses that the program is identified based on a database of viewer preferences that includes characteristics of programming that the viewer selects or receives (*Lawler*, col. 5, lines 52-56). *Lawler's* database represents a viewing history that includes certain "predetermined characteristics" of programming transmitted over the interactive television system, such as whether the programs are movies, talk shows, sports, etc. (*Lawler*, col. 5, line 56 to col. 6, line 1).

*Lawler* also discloses using a polling method to ensure that the viewer is actually watching the program (*Lawler*, col. 10, lines 11-14). As an example, *Lawler* displays a "query icon" on the display, and requesting that the viewer acknowledge their presence (*Lawler*, col. 10, lines 14-17). In addressing claim 30, the Office Action alleges that, from these disclosures in *Lawler*:

It would have been obvious to one of ordinary skill in the art at the time the invention was made that the polling must take place over the duration of the program itself. Thus, programs with shorter duration, such as news program would require a lower threshold than programs such as dramatic movies which have a longer duration. The rational for such a lower threshold is that common sense dictates that polling for a 30 minute program must occur within the first 30 minutes in order to be sure the

viewer watched the program, while polling for a 2 hour movie can occur any time within the 2 hour time frame. As there are a limited number of predictable thresholds from which to choose for polling within a program of a given time length and the viewer initially chose to watch the program, it would be predictable to choose a threshold that is closer to the end of any given program in order to ensure that that majority of the program was indeed viewed by the viewer.

(Office Action at pages 6-7). However, *Lawler* does not teach or suggest using different polling durations for programs of different categories. Indeed, the allegations cited above find no basis in the teachings of *Lawler* or any other reference of record. To the extent that the Office Action may be relying on Official Notice, Applicants respectfully request that the next communication expressly set forth any such Official Notice. Further, Applicants respectfully request that the Examiner provide documentary support, as required by M.P.E.P. § 2144.03(c).

Further, to the extent that the passage cited above may refer to allegedly inherent features of *Lawler*, Applicants refer to MPEP § 2112 (IV), which states: "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art" (emphasis added). As discussed above, the Office Action alleges that programs of shorter durations would require shorter polling periods. However, this is not necessarily the case, at least because polling periods for shorter programs would clearly be sufficient for monitoring longer programs. Indeed, *Lawler* is silent as to any variation in the polling periods, much less tailoring the polling periods to programs of particular lengths as alleged in the Office Action. Accordingly, *Lawler* does not teach or suggest "storing data in a program viewing log reflecting a first duration of time that a first viewer viewed

a first program, the first program corresponding to a first program category from a plurality of program categories[, and] comparing the duration of time the first viewer viewed the first program to a threshold duration particular to the first program category," as recited by independent claim 1 (emphasis added).

*Cannon* fails to cure the deficiencies of *Lawler*. *Cannon* discloses a "method and apparatus for quickly and easily retrieving, manipulating and analyzing large quantities of computer-based data relevant to television-viewing consumers" (*Cannon*, abstract). The Office Action alleges that *Cannon* discloses "provid[ing] television viewing habit information to advertisers" (Office Action at page 4). However, even assuming this is the case (a position Applicants do not concede), *Cannon* still does not teach or suggest "storing data in a program viewing log reflecting a first duration of time that a first viewer viewed a first program, the first program corresponding to a first program category from a plurality of program categories[, and] comparing the duration of time the first viewer viewed the first program to a threshold duration particular to the first program category," as recited by independent claim 1 (emphasis added).

Because the cited references fail to teach or suggest each and every claim element, no *prima facie* case of obviousness has been established with respect to claim 1. Independent claims 9 and 17 distinguish over *Lawler* and *Cannon* for at least similar reasons as claim 1. Claims 19, 20, and 28-34 depend from claim 1, and are allowable at least due to their dependence. Applicants therefore respectfully request the Examiner to withdraw the rejection of these claims under 35 U.S.C. § 103(a).

**III. The Rejection of Claim 27 under 35 U.S.C. § 103(a)**

Applicants respectfully traverse the rejection of claim 27 under 35 U.S.C. § 103(a) as unpatentable over *Lawler* and *Cannon* in view of *Williams*. Claim 27 depends from claim 1. As already discussed, *Lawler* and *Cannon* fail to teach or suggest certain features of claim 1.

*Williams* discloses a method and apparatus for automatically configuring a system based on a user's monitored system interaction (*Williams*, abstract). The Office Action alleges that *Williams* discloses "preferred programming available on a date and at a time selected by the viewer (Office Action at page 8). However, even assuming this is the case (a position Applicants do not concede), *Williams* still does not teach or suggest "storing data in a program viewing log reflecting a first duration of time that a first viewer viewed a first program, the first program corresponding to a first program category from a plurality of program categories[, and] comparing the duration of time the first viewer viewed the first program to a threshold duration particular to the first program category," as recited by independent claim 1 (emphasis added).

For at least the reasons discussed above, no *prima facie* case of obviousness has been established with respect to claim 27, at least to its dependence from claim 1. Applicants therefore respectfully request the Examiner to withdraw the rejection of claim 27 under 35 U.S.C. § 103(a).

**IV. Conclusion**

In view of the foregoing remarks, Applicants respectfully request reconsideration of the application and withdrawal of the rejections. The pending claims are in condition for allowance.

Please grant any extensions of time required to enter this response and charge  
any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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